



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,237	08/16/2001	Quintin T. Phillips	10006507-1	4805

7590 09/11/2007
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

VAN BRAMER, JOHN W

ART UNIT	PAPER NUMBER
----------	--------------

3622

MAIL DATE	DELIVERY MODE
-----------	---------------

09/11/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/932,237
Filing Date: August 16, 2001
Appellant(s): PHILLIPS ET AL.

MAILED

SEP 11 2007

GROUP 3600

James D. Shaurette
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 4, 2007 appealing from the Office action mailed December 12, 2006.

(1) Real Party in Interest

- A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

- The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

- The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

- The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

- The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

- The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

- The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

- Shimbori et al., US Patent Application Publication: US 2004/0204986

(9) Grounds of Rejection

- The following ground(s) of rejection are applicable to the appealed claims:

Claims 1- 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Shimbori et al. (U.S. Patent Application Publication: US 2004/0204986).

Claim 1: Shimbori discloses an article of manufacture comprising:

- a. A processor-usable medium having processor-useable code embodied therein and configured to cause processing circuitry to perform steps comprising:
 - i. Providing a marketing message intended for an image forming device user from a party other than a provider of a consumable. (Page 2, Paragraph [0041])
 - ii. Monitoring an association of a consumable with an image forming device. (Page 2, Paragraph [0044])
 - iii. Enabling communication of the marketing message to the image forming device user responsive to the monitoring. (Page 2, Paragraph [0042])

Claim 2: Shimbori discloses the article of claim 1 wherein the monitoring comprises monitoring coupling of the consumable and the image-forming

device. (Page 2, Paragraph [0044])

Claim 3: Shimbori discloses the article of claim 1 wherein the enabling comprises accessing the marketing message from a memory device of the consumable. (Page 2, Paragraph [0042])

Claim 4: Shimbori discloses the article of claim 1 wherein the enabling comprises accessing an identifier of the marketing message from a memory device of the consumable. (Page 2, Paragraph [0043])

Claim 5: Shimbori discloses the article of claim 1 wherein the enabling comprises communicating the marketing message to the image-forming device. (Page 3, Paragraph [0049])

Claim 6: Shimbori discloses the article of claim 1 wherein the providing comprises providing the marketing message comprising a message unrelated to the consumable and unrelated to the image forming device. (Page 4, Paragraph [0070])

Claim 7: Shimbori discloses the article of claim 1 wherein the code is further configured to cause the processing circuitry to perform the step including offering the marketing message to parties other than providers of the

consumable and the providing is responsive to the offering. (Page 2, Paragraph [0042]) and Page 6, Paragraph [0082])

Claim 8: Shimbori discloses a marketing method to image forming device users comprising:

- a. Providing a consumable usable in an image forming device to form hard images and usable to enable a marketing function with respect to image forming device users. (Page 2, Paragraph [0040])
- b. Making available the marketing function to other parties apart from a provider of the consumables. (Page 2, Paragraph [0041] through Paragraph [0042])
- c. Receiving an indication regarding a desirous party to utilize the marketing function. (Page 2, Paragraph [0041])
- d. Enabling the marketing function for the desirous party using the consumable. (Page 2, Paragraph [0041])
- e. Initiating the marketing function after the enabling. (Page 2, Paragraph [0042])

Claim 9: Shimbori discloses the method of claim 8 wherein the initiating the marketing function comprises communicating a marketing message for the desirous party using the image-forming device. (Page 2, Paragraph [0042])

Claim 10: Shimbori discloses the method of claim 9 wherein the communicating comprises communicating the marketing message comprising a message unrelated to the consumable and unrelated to the image forming device. (Page 4, Paragraph [0070])

Claim 11: Shimbori discloses the method of claim 8 wherein the initiating comprises communicating a marketing message using an image-forming device. (Page 2, Paragraph [0042])

Claim 12: Shimbori discloses the method of claim 8 further comprising detecting a triggering event with respect to the consumables and wherein the initiating is responsive to the detecting. (Page 2, Paragraph [0044])

Claim 13: Shimbori discloses the method of claim 12 wherein the initiating comprises communicating a marketing message. (Page 6, Paragraph [0082])

Claim 14: Shimbori discloses the method of claim 12 wherein the detecting the triggering event comprises detecting coupling of the consumable with an image-forming device. (Page 2, Paragraph [0044])

Claim 15: Shimbori discloses the method of claim 12 wherein the detecting the triggering event comprises detecting a condition of the consumable

reaching a predetermined level. (Page 5, Paragraphs [0080] through [0081])

Claim 16: Shimbori discloses the method of claim 8 wherein the

- a. Providing the consumable comprises providing the consumable configured to enable the marketing function comprising communication of a marketing message associated with the desirous party. (Page 2, Paragraph [0040])
- b. The consumable comprises memory device configured to store the marketing message. (Page 1, Paragraphs [0015] through [0016])
- c. The enabling comprises storing the marketing message using the memory device. (Page 2, Paragraph [0042])
- d. The initiating comprises accessing the marketing message from the memory device and communicating the marketing message using the image-forming device after the accessing. (Page 2, Paragraph [0042])

Claim 17: Shimbori discloses the method of claim 8 wherein

- a. The consumable comprises a memory device. (Page 5, Paragraph [0075])
(The terms consumable and memory device are very broad. Even the paper, described in the cited paragraph can represent a consumable that is a memory device, since people use paper to print or write notes that aid in the memory of various items. Additionally, the printer itself is a consumable with a memory device because it has a useful life that will eventually be consumed.)

- b. The enabling comprises storing an identifier within the memory device to identify the marketing function for the desirous party. (Page 5, Paragraph [0075])
- c. The initiating comprises accessing the identifier. (Page 5, Paragraph [0075])
- d. Associating the consumable with an image-forming device. (Page 5, Paragraph [0075])
- e. First communicating the identifier externally of the image-forming device to identify the marketing function comprising a marketing message for the desirous party after the associating. (Page 5, Paragraph [0075])
- f. Receiving a marketing message within the image-forming device responsive to the first communicating. (Page 5, Paragraph [0075])
- g. Second communicating the marketing message using the image-forming device. (Page 5, Paragraph [0075])

Claim 18: Shimbori discloses the method of claim 8 wherein the enabling comprises

- a. Monitoring the consumable utilizing an external device with respect to the image forming device. (Page 5, Paragraph [0079])
- b. Detecting a status of the consumable reaching a predetermined status. (Page 5, Paragraph [0080])

Art Unit: 3622

- c. Wherein the initiating the marketing function comprises forwarding a marketing message to the image-forming device utilizing the external device responsive to the detecting status. (Page 2, Paragraph [0041])
- d. Communicating the marketing message using the image-forming device responsive to the detecting status. (Page 2, Paragraph [0042])

Claim 19: Shimbori discloses the method of claim 8 wherein the making available comprises offering electrical storage space of a memory device of a consumable to the other parties. (Page 4, Paragraph [0070])

Claim 20: Shimbori discloses a marketing method to printer users comprising:

- a. Providing a consumable usable in a printer to print hard images and usable to enable communication of a marketing message with respect to printer users. (Page 2, Paragraph [0040])
- b. Offering the contents of the marketing message to other parties apart from a provider of the consumables. (Page 2, Paragraph [0041])
- c. Receiving an indication regarding a desirous party to utilize the marketing message. (Page 2, Paragraph [0041])
- d. Enabling a marketing message for the desirous party using the consumable and wherein the marketing message is unrelated to the

printer and unrelated to the consumable. (Page 2, Paragraph [0042] and Page 4, Paragraph [0070])

- e. Detecting a triggering event with respect to the consumable after the associating. (Page 4, Paragraph [0070], [0073] and Page 5, Paragraph [0075])
- f. Initiating communication of the marketing message using the printer responsive to the detecting. (Page 4, Paragraph [0070], [0073] and Page 5, Paragraph [0075])

Claim 21: Shimbori discloses the article of claim 1 wherein the enabling comprises enabling responsive to the monitoring detecting the association comprising installation of the consumable within the image forming device. (Page 5, Paragraph [0075]) (Detection of the paper is performed and printing is enabled)

Claim 22: Shimbori discloses the method of claim 8 wherein the enabling comprises storing electrical data related to the marketing function using an electrical memory device of the consumable. (Page 4, Paragraph [0070])

Claim 23: Shimbori discloses the method of claim 8, wherein the enabling the marketing function comprises storing a marketing message in the form of

electrical data using an electrical memory device of the consumable. (Page 4, Paragraph [0070])

Claim 24: Shimbori discloses the method of claim 17 wherein the enabling comprises storing electrical data of the identifier within the memory device comprising an electrical memory device configured to store the electrical data. (Page 4, Paragraph [0070] and Page 5, Paragraph [0075])

Claim 25: Shimbori discloses the method of claim 20 wherein the initiating communication comprises initiating printing of the marketing message using the printer. (Page 4, Paragraph [0070], [0073] and Page 5, Paragraph [0075])

(10) Response to Argument

Independent Claim 1

The applicant's argue that Shimbori does no teach monitoring the association of the consumable and the image-forming device. The applicants submit that the monitoring of the capacity of the consumable as taught by Shimbori in paragraph [0044] does not suggest monitoring the association of the consumable and the image-forming device as claimed. In order to prosecute the claimed limitations the examiner has relied upon the following paragraphs of the applicant specification: Page 4, Paragraph [0022] describes the claimed consumable as

"Exemplary consumables utilized within a given image forming device include imaging media (e.g., paper, transparencies, etc.), marking agents (e.g., toner), components having fixed life spans (e.g., developer assembly) and other expendable items utilized to complete desired jobs.";

Page 12, Paragraph [0055] discloses that the coupling or installation of the consumable are examples of "association".

"As described above, a variety of occurrences or operations are utilized to trigger marketing operations according to aspects of the invention. For example, the association (e.g., installation or coupling) of a consumable 34 with an image forming device 12 may be utilized to initiate marketing operations or functions including communication of messages to users".

Page 6, Paragraph [0032] of the applicant's specification discloses that an examples of monitoring includes monitoring a remaining amount of consumable.

"For example, sensor 27 monitors a remaining amount of consumable 34. In another embodiment, sensor 27 monitors usage of consumable 34 to determine the status of consumable 34. In yet another embodiment, sensor 27 is omitted and processing circuitry 28 monitors usage of consumable 34 (e.g., monitors number of pixels imaged to approximate usage of toner) to determine the status of consumable 34. Other sensing operations or structures are possible."

Therefore, Shimbori clearly establishes that the association of the consumable is monitored in paragraph [0044] where he states:

"The consumables ordering apparatus 20 checks the remaining amount of consumables, such as the number of sheets or the remaining amount of ink, used by the printer 50, and automatically places an order so as to avoid lack of consumable items."

The applicant also argues that monitoring the whether or not the printing has been finished normally, and whether or not paper that has been used in the printing was correct paper as taught by Shimbori in Paragraph [0047] does not constitute monitoring the association of the consumable with the image forming device. However, Page 6, Paragraph [0032] of the applicant's specification discloses that other sensing operation are also considered types of monitoring and Shimbori is disclosing in Paragraph [0047] the monitoring of the current status of a consumable with regard to the printing process and as such satisfies the limitations imposed by Claim 1.

The applicant's further argue that Paragraph [0047] of the Shimbori reference refers to operations that occur after the printing and that post-printing operations fail to suggest the claimed "monitoring the association of the consumable with the image forming device" in combination with the "enabling communication of the message responsive to the monitoring" because the communication has already occurred. However, the examiner disagrees, Shimbori is specifically describing monitoring whether the printing of the consumable (paper) finished normally. If the printing did finish normally then the printed product is communicated to the user in the proper fashion.

However, if the printed product did not complete normally then the printed product has not been communicated in the intended fashion. As such, enabling the communication of the message is responsive to the monitoring. The applicant further argues that Paragraph [0042] of the Shimbori reference occurs after printing and as such fails to suggest enabling communication of the marketing message to the user responsive to the monitoring of the association. However, the applicant is attempting place more stringent limitations on the current claims while providing piecemeal arguments directed at individual paragraphs of the Shimbori reference, rather than regarding the reference as a whole. The claim limitations, as currently stated, merely require the provision of a marketing message to be sent to a user, the monitoring of an association of a consumable such a paper or ink, and the enablement of a communication of the marketing message to the user responsive to the monitoring. Shimbori, when taken as a whole and specifically the cited paragraphs [0041], [0042] and [0044], discloses an advertisement to be sent to a user image forming device, monitoring the level of consumables, and printing the advertisement responsive to the monitoring, since charges for the printing are based upon usage of the consumable. Additionally, the lack of remaining consumable (i.e. no more paper, no more ink) would inherently result in the inability to print the advertisement. As such, all limitations of the claim have been satisfied.

Independent Claim 8

The applicant argues that the office action relies upon the teaching of paragraph [0040] of the Shimbori reference to teach the claimed providing a consumable usable in an image forming device to form hard images and usable to enable a marketing function with respect to image forming device users but fails to provide any explanation as to how paragraph [0040] teaches the claimed providing. However, the referenced paragraph is self explanatory when taken in context of the disclosure. Shimbori discloses in paragraph [0040] the printing of an advertisement which is a hard copy, as evidence from referenced Fig. 1. Therefore, a hard image printed on a consumable and usable in a marketing function is disclosed. The applicant is reminded that they are responsible for understanding the entire cited reference as a whole and may not rely upon only the phrasing of the cited paragraphs. The cited references are merely a guide to help the applicant understand the interpretation the examiner has used in applying the prior art reference.

The applicants argue that the citing of paragraphs [0041] through [0042] of the Shimbori reference to describe the claimed limitation of "making available the marketing function to other parties apart from the provider of the consumables is insufficient. The examiner is unclear as to the applicants reasoning behind such an allegation, but maintains that paragraphs [0041] through [0042] of the Shimbori reference teach that the hard copy advertisement that is printed on the consumable can be from any advertiser

that provides items or services. Therefore the marketing function is available to other parties apart from the provider of the consumable.

The applicant argues that they have failed to uncover any teaching in paragraph [0041] of the Shimbori reference that teaches “receiving an indication regarding a desirous party to utilize the marketing function”.

However, Shimbori specifically states that a user requests the printing of the advertisement. Such a request is an indication from the user (desirous party) to utilize the marketing function.

The applicant argues that paragraph [0043] of the Shimbori reference does not teach the claimed limitation of initiating the marketing function because after the printing occurs no initiating of the marketing function can occur.

However, Shimbori discloses the initiating of the marketing function that occurs after enabling as the interaction of the user with the store during redemption. The marketing function has been initiated by its use. Therefore, all positively recited limitations in the claim as currently written have been disclosed by the Shimbori.

Independent Claim 20

The applicant argues that Shimbori does not teach the limitation of “providing a consumable” that is “usable in a printer to print hard images” and “usable to enable communication of a marketing message”. However, the Shimbori reference teaches, in paragraph [0040], the printing of a hard copy of an

advertisement. As can be seen by reference Fig 1, a hard copy of an advertisement containing a bar code is printed. Thus the consumables (paper and ink), are used to print the hard image and to communicate the marketing message. Additional supporting evidence can be found in paragraphs [0041] through paragraphs [0042]. The applicant further argues that the Office has improperly relied upon the single function of using a consumable to print as allegedly teaching plural different limitations. However, the applicants claimed limitation is for providing a consumable which has dual usage, one being that it is usable in a printer to print hard images and the other is that it is usable to enable communication of a marketing message. As such, the rejection as written is proper and teaches the recited limitation.

The applicant argues that Shimbori, paragraph [0041] does not disclose "receiving an indication regarding a desirous party to utilize the marketing function. However, the cited paragraph discloses a user who desires to use an advertisement, indicating that the advertisement should be printed.

The applicant argues that Shimbori does not disclose "enabling a marketing message using the consumable" in combination with "initiating communication of the marketing message. However, as stated in the Office Action dated December 12, 2006, Shimbori discloses the monitoring of consumables and based on said monitoring enabling the ability to print an advertisement, then initiating the printing of said advertisement in Paragraphs [0042], [0070],

[0073], and [0075]. As such the limitation of the claims as currently written have been disclosed.

The applicants argue that Shimbori does not disclose the “detecting of a triggering event with respect to a consumable” and “initiating communication of the marketing method”. However, paragraph [0075] disclose two triggering events with respect to the consumable. A detection trigger regarding the type of paper and a detection trigger of whether the printing has completed normally. Both detection indicate that initiation of the communication if either stopped until the proper paper is exchanges or the marketing communication is reprinted in the event that the printing did not complete normally.

Additionally, the applicant argues that the disclosure of Shimbori in Paragraph [0073] that unit 150 notifies unit 10 that the number of printed sheets exceeds the limit so as to prevent printing is contrary to initiating communication of the marketing method. However, the applicant has failed to grasp that a check is made as to whether the printed sheets has exceeded the limit (a trigger event with respect to a consumable); and when it is determined that the limit has not yet exceeded the limit the advertisement able to be printed (initiating communication of the marketing method. Thus all positively recited limitations of the claims as currently written have been disclosed by the Shimbori reference.

Dependent Claim 2

The applicants argue that Shimbori does not teach “monitoring coupling of the consumable and the image-forming device. The applicants submit that the monitoring of the capacity of the consumable as taught by Shimbori in paragraph [0044] does not suggest monitoring the association of the consumable and the image-forming device as claimed. However, on Page 12, Paragraph [0055] of the applicant’s specification the coupling or installation of the consumable are examples of “association”. Additionally Page 6, Paragraph [0032] of the applicant’s specification discloses that an examples of monitoring includes monitoring a remaining amount of consumable. Therefore, Shimbori clearly establishes that the coupling of the consumable is monitored in paragraph [0044] where he states:

“The consumables ordering apparatus 20 checks the remaining amount of consumables, such as the number of sheets or the remaining amount of ink, used by the printer 50, and automatically places an order so as to avoid lack of consumable items.”

Dependent Claim 3

The applicant argues that the Shimbori reference does not disclose “accessing the marketing message from a memory device of the consumable”. However, Shimbori teaches, in paragraph [0042] the printing of a hard copy of an advertisement on a consumable (paper). Since a hard copy of printed matter is memory device consisting of the combination of

consumables (ink and paper) and the act of reading the hard copy or giving the hard copy to someone else to read is accessing. The applicant's specification provides no definition of the term "consumable" that would invalidate this interpretation, the applicant's specification describes exemplary consumables as items utilized within a given image forming device include imaging media (e.g., paper, transparencies, etc.), marking agents (e.g., toner), components having fixed life spans (e.g., developer assembly) and other expendable items utilized to complete desired jobs. Given this definition the image-forming device itself is a component with a fixed life span. The applicant has made no attempt to more narrowly limit the claimed "consumable" to "a memory contained in a toner cartridge" as disclosed by one embodiment of the applicant's specification.

Dependent Claim 4

The applicant argues that Shimbori does not disclose "accessing an identifier of the marketing message from a memory device of the consumable". However, Shimbori discloses that the hard copy of the advertisement can contain a bar code (identifier of the marketing message), paragraph [0042], and that the bar code contains information regarding the user and the advertisement. When the advertisement is used the bar code is scanned and the data from the memory device of the consumable (barcode) is stored in a database. The database is then used to determine the effectiveness of the advertisement and to target more effective advertisements to the user.

Dependent Claim 21

The applicant argues that Shimbori does not teach the “enabling the communication of the marketing message responsive to the monitoring detecting the association comprising installation of the consumable within the image forming device. However, as stated in the Office Action dated December 12, 2006, Shimbori specifically discloses in Paragraph [0075] the monitoring of the type of paper installed in the image-forming device.

Dependent Claim 12

The applicant argues that Shimbori does not disclose detecting a triggering event with respect to the consumables and wherein the initiating is responsive to the detecting. However, paragraph [0075] discloses two different triggering events with respect to the consumable. A detection trigger regarding the type of paper and a detection trigger of whether the printing has completed normally. Both detection methods indicate an initiation of the communication by either stopping the printing request until the proper paper is exchanged, at which time initiation of printing occurs or the marketing communication is reprinted (initiation of printing) in the event that the printing did not complete normally. Additionally, the disclosure of Shimbori in Paragraph [0073] that unit 150 notifies unit 10 that the number of printed sheets exceeds the limit so as to prevent printing. Therefore, a detection is made as to whether the printed sheets has exceeded the limit (a trigger event with respect to a consumable), and when it is determined that the limit has not yet exceeded the limit the

advertisement able to be printed (initiating communication of the marketing method.

Dependent Claim 13

Applicant argues that Shimbori does not disclose the initiating of the communication of a marketing message. However, Shimbori discloses initiating the communication of numerous types of marketing messages.

Paragraph [0042] of Shimbori discloses the initiating of a marketing message that is disclosed as the initiating of the printing of an advertisement (marketing message) to a user. Additionally, Shimbori discloses in paragraph [0082], that the consumable managing unit that tracks (monitors) the usage of paper and ink identifies when the system is running low on a consumable or unable to complete a print request due to the amount of consumable remaining (triggers). When the consumable managing unit determines that such a state occurs a marketing message is initiated that requests an identification of the lowest cost trader for the consumable in the market area and an additional marketing message in the form of an order is placed for the consumable from the trader.

Dependent Claim 14

The applicant argues that Shimbori does not disclose "detecting the triggering event comprises detecting coupling of the consumable with an image forming device. However, Shimbori clearly establishes that the coupling of the consumable is monitored in paragraph [0044] where he states:

"The consumables ordering apparatus 20 checks the remaining amount of consumables, such as the number of sheets or the remaining amount of ink, used by the printer 50, and automatically places an order so as to avoid lack of consumable items."

Dependent Claim 16

The applicant argues that Shimbori does not teach a consumable comprising a memory device configured to store a marketing message. However, Shimbori teaches, in paragraph [0042] the printing of a hard copy of an advertisement on a consumable (paper). Since a hard copy of printed matter is memory device consisting of the combination of consumables (ink and paper) and the act of reading the hard copy or giving the hard copy to someone else to read is accessing. The applicant's specification provides no definition of the term "consumable" that would invalidate this interpretation, the applicant's specification describes exemplary consumables as items utilized within a given image forming device include imaging media (e.g., paper, transparencies, etc.), marking agents (e.g., toner), components having fixed life spans (e.g., developer assembly) and other expendable items utilized to complete desired jobs. Given this definition the image-forming device itself is a component with a fixed life span as pointed out by the examiner in an attempt to show how broadly the applicant is attempting to claim their invention. The applicant has made no attempt to more narrowly

limit the claimed "consumable" to "a memory contained in a toner cartridge" as disclosed by one embodiment of the applicant's specification.

Dependent Claim 17

The applicant argues that Shimbori does not disclose the consumable comprises a memory device. However, as stated in the response to arguments regarding dependent claim 16, Shimbori teaches, in paragraph [0042] the printing of a hard copy of an advertisement on a consumable (paper). Since a hard copy of printed matter is memory device consisting of the combination of consumables (ink and paper) and the act of reading the hard copy or giving the hard copy to someone else to read is accessing. The applicant's specification provides no definition of the term "consumable" that would invalidate this interpretation, the applicant's specification describes exemplary consumables as items utilized within a given image forming device include imaging media (e.g., paper, transparencies, etc.), marking agents (e.g., toner), components having fixed life spans (e.g., developer assembly) and other expendable items utilized to complete desired jobs. Given this definition the image-forming device itself is a component with a fixed life span as pointed out by the examiner in an attempt to show how broadly the applicant is attempting to claim their invention. The applicant has made no attempt to more narrowly limit the claimed "consumable" to "a memory contained in a toner cartridge" as disclosed by one embodiment of the applicant's specification.

The applicant argues that Shimbori further fails to teach or suggest storing an identifier within the memory device to identify the marketing function, accessing the identifier, accessing the identifier, communicating the identifier externally of the image forming device to identify the marketing function, receiving the marketing message within the image forming device and communicating the marketing message using the information forming device. However, paragraph [0075] of Shimbori discloses a hard copy printed document containing a bar code associated with the advertisement. The bar code contains information regarding the user and the advertisement. A printing request is made and the system checks to see if the proper paper associated with the user is present. Then the advertisement containing the bar code is communicated from the Internet to the image forming devices. When the image-forming device receives the advertisement and the proper paper is present the advertisement is printed (communicated using the image-forming device).

Dependent Claim 18

The applicant argues that Shimbori fails to disclose monitoring a consumable utilizing an external device with respect to the image forming device because Shimbori discloses in paragraph [0079] that unit 210 is part of the printer. While such a disclosure is made, Shimbori also discloses in paragraph [0079] that terminal unit 10 (which is an external device) makes unit 210 of the printer check the status of the consumables in the printer and report the

results of said checking back to the terminal unit. As such a consumable is being monitored utilizing an external device with respect to the image forming device.

The applicant argues that Shimbori fails to disclose communicating the marketing message to the image forming device responsive to the detecting status of the consumable. . However, Shimbori clearly establishes that the coupling of the consumable is monitored in paragraph [0044] where he states:

"The consumables ordering apparatus 20 checks the remaining amount of consumables, such as the number of sheets or the remaining amount of ink, used by the printer 50, and automatically places an order so as to avoid lack of consumable items."

As can be seen from Fig. 1, the consumable ordering apparatus 20 is external to both the printer 50 and terminal unit 10 (Shimbori also discloses in paragraph [0086] that the consumable ordering apparatus 20 and the terminal unit 10 can be part of a single apparatus). Shimbori further discloses in paragraph [0079] that "the terminal unit 10 makes the remaining amount monitoring unit 210 of the printer 50 check the remaining amount and the consumed amount of the consumables of the printer 50 (Step S270). The found remaining amount and the consumed amount of the consumables are transmitted to the terminal unit 10 together with the printer ID and the item ID of each item of the consumables (Step S280)" and in paragraph [0080] that "The consumables managing unit 200 determines whether or not the

remaining amount of the consumables is enough (Step S310). When the remaining amount is enough the marketing message is communicated to the image forming device and a hard copy of the advertisement is printed as disclosed in paragraphs [0041]-[0042].

Dependent Claim 19

The applicant argues that Shimbori fails to disclose an electrical storage space of a memory device of a consumable. However, Shimbori discloses in paragraphs [0013] through [0015] that the printer may include a printing certifying unit and a printing managing apparatus. Both said unit and apparatus are considered consumables based upon the applicants specification (Applicants Specification paragraph [0022]) since they are components having a fixed life span. Paragraph [0016] of Shimbori discloses that the printer managing device includes a user database which stores the user's printing environment criteria. Shimbori further discloses in paragraph [0075] that the printing monitoring unit is accessed when the printer receives a request from to print an advertisement from an advertiser. The user's paper preference is then applied to the print request. If the proper paper is installed the advertisers message is made available to the user via printing the advertisement. When the proper paper is not installed the message is not made available to the user until such a time as the proper paper is installed. Additionally, while the printer waits for corrective action to be performed, it is also inherent that the print job comprising the marketing message is sitting in

a memory device of the printer since Shimbori discloses that in the case where a printing has not been completed normally, the printing is tried again. Such a memory device also satisfies the limitation of a consumable since it is a component of the printer with a fixed life span.

Dependent Claim 22

The applicant argues that Shimbori fails to disclose storing electrical data related to the marketing function using an electrical memory device of the consumable. However, Shimbori discloses in paragraphs [0013] through [0015] that the printer may include a printing certifying unit and a printing managing apparatus. Both said unit and apparatus are considered consumables based upon the applicants specification (Applicants Specification paragraph [0022]) since they are components having a fixed life span. Paragraph [0016] of Shimbori discloses that the printer managing device includes a user database which stores the user's printing environment criteria. Shimbori further discloses in paragraph [0075] that the printing monitoring unit is accessed when the printer receives a request from to print an advertisement from an advertiser. The user's paper preference is then applied to the print request. If the proper paper is installed the advertisers message is made available to the user via printing the advertisement. When the proper paper is not installed the message is not made available to the user until such a time as the proper paper is installed. Additionally, while the printer waits for corrective action to be performed, it is also inherent that the

print job comprising the marketing message is sitting in a memory device of the printer since Shimbori discloses that in the case where a printing has not been completed normally, the printing is tried again. Such a memory device also satisfies the limitation of a consumable since it is a component of the printer with a fixed life span.

Dependent Claim 23

The applicant argues that Shimbori fails to disclose storing a marketing message in the form of electrical data using an electrical memory of the consumable. However, Shimbori discloses in paragraphs [0013] through [0015] that the printer may include a printing certifying unit and a printing managing apparatus. Both said unit and apparatus are considered consumables based upon the applicant's specification (Applicant's Specification paragraph [0022]) since they are components having a fixed life span. Paragraph [0016] of Shimbori discloses that the printer managing device includes a user database which stores the user's printing environment criteria. Shimbori further discloses in paragraph [0075] that the printing monitoring unit is accessed when the printer receives a request from to print an advertisement from an advertiser. The user's paper preference is then applied to the print request. If the proper paper is installed the advertiser's message is made available to the user via printing the advertisement. When the proper paper is not installed the message is not made available to the user until such a time as the proper paper is installed. Additionally, while the

printer waits for corrective action to be performed, it is also inherent that the print job comprising the marketing message is sitting in a memory device of the printer since Shimbori discloses that in the case where a printing has not been completed normally, the printing is tried again. Such a memory device also satisfies the limitation of a consumable since it is a component of the printer with a fixed life span.

Dependent Claim 24

The applicant argues that Shimbori fails to disclose storing an electrical identifier within the memory device of the consumable comprising an electrical memory device configured to store the electrical data. However, Shimbori discloses in paragraphs [0013] through [0015] that the printer may include a printing certifying unit and a printing managing apparatus. Both said unit and apparatus are considered consumables based upon the applicants specification (Applicants Specification paragraph [0022]) since they are components having a fixed life span. Paragraph [0016] of Shimbori discloses that the printer managing device includes a user database which stores the user's printing environment criteria. Shimbori further discloses in paragraph [0075] that the printing monitoring unit is accessed when the printer receives a request from to print an advertisement from an advertiser. The user's paper preference is then applied to the print request. If the proper paper is installed the advertisers message is made available to the user via printing the advertisement. When the proper paper is not installed the message is not

made available to the user until such a time as the proper paper is installed. Additionally, while the printer waits for corrective action to be performed, it is also inherent that the print job comprising the marketing message containing a bar code identifier is sitting in a memory device of the printer since Shimbori discloses that in the case where a printing has not been completed normally, the printing is tried again. Such a memory device also satisfies the limitation of a consumable since it is a component of the printer with a fixed life span.

Dependent Claim 25

The applicant argues that Shimbori fails to disclose detecting a triggering even with respect to the consumable in combination with the claimed initiating printing of the marketing message using the printer responsive to the detecting the trigger event. However, paragraph [0075] discloses two different triggering events with respect to the consumable. A detection trigger regarding the type of paper and a detection trigger of whether the printing has completed normally. Both detection methods indicate an initiation of the communication by either stopping the printing request until the proper paper is exchanged, at which time initiation of printing occurs or the marketing communication is reprinted (initiation of printing) in the event that the printing did not complete normally. Additionally, the disclosure of Shimbori in Paragraph [0073] that unit 150 notifies unit 10 that the number of printed sheets exceeds the limit so as to prevent printing. Therefore, a detection is made as to whether the printed sheets has exceeded the limit (a trigger event

Art Unit: 3622

with respect to a consumable), and when it is determined that the limit has not yet exceeded the limit the advertisement able to be printed (initiating communication of the marketing method.

(11) Related Proceeding(s) Appendix

- No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

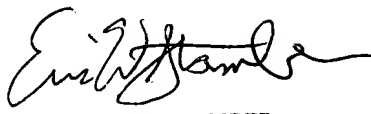
John Van Bramer



Conferees:

Eric Stamber 

James Myhre 



ERIC W. STAMBER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600